



Paper No. 8

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 91614

COPY MAILED

AUG 15 2002

OFFICE OF PETITIONS

In re Application of
Zha, et al.
Application No. 10/042,128
Filed: January 7, 2002
Attorney Docket No. USFMC.R.066C3:
DECISION DISMISSING
:
PETITION
:
:

This is a decision on the petition filed April 8, 2002, requesting entry of Figure 16 as part of the disclosure.

The application was filed on January 7, 2002. However, on February 4, 2002, the Office mailed a "Notice to File Missing Parts" (Notice), stating that the application had been accorded a filing date of January 7, 2002, and requiring the submission of the statutory basic filing fee, additional claim fees, and a surcharge for the late filing fee. Additionally, the Notice advised applicants that the drawing of Figure 16 described in the specification appeared to have been omitted.

In response, on April 8, 2002, applicants filed, inter alia, the present petition, an authorization to charge the \$130.00 petition fee, and a copy of Figure 16. Applicants admit that they inadvertently omitted Figure 16 on filing the application papers. Applicants request entry of Figure 16 because it does not contain new matter.

It is noted that the application transmittal letter identified this application as a continuation application of prior application No. 09/336,059, filed June 18, 1999, and specifically incorporated by reference the disclosure of the prior application. Section 201.06(c) of the Manual of Patent Examining Procedure states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, the drawing of Figure 16 is not new matter if it was a part of the disclosure of the prior application.

However, as applicants admit, Figure 16 was not present on the filing of the above-identified application. Accordingly, the Notice mailed on February 4, 2002, was correct in stating that Figure 16 described in the specification had been omitted. Therefore, the requirement for the omitted figure was proper and will not be withdrawn.

Accordingly, the petition is dismissed.

The \$130.00 petition fee was charged to Deposit Account No. 11-1410, as authorized in the petition.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of January 7, 2002, using the application papers filed on that date.

Thereafter, the application will be forwarded to Technology Center 1700 for consideration by the examiner of the petition filed April 8, 2002, as an amendment requesting the entry of a new sheet of drawing.

Any inquiries related to this decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy